

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Docket No. 02-420-H

In re Patent of Rice <i>et al.</i>)	
)	
Patent No.: 7,576,074)	
Application No.: 10/522,004)	Group Art Unit: 1624
)	
Issue Date: August 18, 2009)	
Filing Date: April 11, 2005)	Confirmation No.: 5083
(371(c) Date))	
)	
Entitled: RECEPTOR-TYPE KINASE)	Examiner: MURRAY, Jeffrey H
MODULATORS AND METHODS OF USE)	

PETITION FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT FILED
UNDER 37 C.F.R. § 1.705(d)

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The patentee petitions for adjustment of the Patent Term Adjustment (“PTA”) of U.S. Patent 7,576,074. The patentee submits that adjustments under 35 U.S.C. § 154(b)(1)(A) (“A delays”) and 35 U.S.C. § 154(b)(1)(B) (“B delays”) have not been properly accorded pursuant to 35 USC § 154(b)(2)(A). As a result, the patentee is being denied a portion of patent term to which it is entitled. Specifically, the patentee submits it is entitled to 1027 days of PTA, not the 475 days as calculated by the Patent Office.

Under 35 USC § 154(b), a patent is entitled to additional patent term (i.e., PTA) equal to Patent Office delays in examination minus patent applicant prosecution delays(35 USC § 154(b)(2)(C)). In arriving at the PTA, the patentee submits that the Office has erred in two respects. First, it appears the Office used the incorrect starting date for calculating the B delay. As described more fully below, at arriving at a PTA of 475 days, the patentee has deduced that the Office based the starting date for calculating the B delay on the § 371(c) date rather than the § 371(b) date as required by 37 CFR § 1.703(b).

CERTIFICATE OF TRANSMISSION (37 C.F.R. 1.8)

I hereby certify that this correspondence is being transmitted to the USPTO via the USPTO EFS on August 21, 2009.

Date: August 21, 2009

/Michael S. Greenfield/
Michael S. Greenfield

Second, the Office has incorrectly interpreted 35 USC § 154(b)(2)(A), resulting in an incorrect figure for the Patent Office delay. Under the Patent Office's interpretation, the Patent Office delay is the longer of the A and B delays. But following *Wyeth v. Dudas*, 580 F. Supp. 2d 138 (D.D.C. Sept 30, 2008), the Patent Office delay is the sum of the A and B delays minus the number of overlapping days.

Turning to the present case, the A delay is 466 days for two Office delays:

1. 465 days for issuing a first action under 35 U.S.C. § 132 at 14 months and 465 days after the '004 application completed the requirements of 35 U.S.C. § 371(c) (37 CFR § 1.703(a)(1)); and
2. 1 day for issuing an action under 35 U.S.C. § 132 on October 28, 2008, at 4 months and 1 day after Applicant's June 27, 2008 reply (37 CFR § 1.703(a)(2)).

The B delay is the number of days an application was pending beyond 3 years. As the '004 application is the national stage of PCT/US03/21923, the starting date of the 3 year pendency period is the day of commencement of the US national phase of the '923 PCT application under 35 USC § 371(b). The '923 PCT application claimed priority to U.S. Provisional Application No. 60/396,269, filed July 15, 2002. So, the '923 PCT application's national stage commenced date is 30 months from July 15, 2002, *i.e.*, on January 15, 2005. The B delay period begins the day after 3 years after the date the national stage commenced, which is January 16, 2008. So, the B delay is the period from January 16, 2008, to the issue date, August 18, 2009, or 581 days.

In the Office's PTA calculation, it appears the B delay was calculated based on the 35 USC § 371(c) date rather than the 35 USC § 371(b) date. The Patent Office calculated the B delay starting from April 12, 2008 (3 years plus one day after the § 371(c) date) and ending August 18, 2009 (the issue date), thus arriving at 494 days rather than 581 days.

The patentee's delay is 19 days for filing an amendment under 37 CFR § 1.312 after a notice of allowance was issued. The delay period ran from the amendment filing date, June 4, 2009, until the Office responded to the amendment on June 22, 2009.

Using the Office's calculation of the B delay and its interpretation of 35 USC § 154(b)(2)(C), the Patent Office took the longer of the A and B delays (which was 494 days) and

subtracted the patentee delay of 19 days to arrive at a PTA of 475 days. Had the Office used the proper B delay of 581 days, it would have arrived at a PTA of $581 - 19 = 562$ days.

But as noted above, the patentee also submits that the Patent Office has construed 35 USC § 154(b)(2)(A) incorrectly. Following the *Wyeth* decision, the Patent Office delay is the sum of the A delays and B delays minus the number of days each of these periods occur on the same calendar day. In the present case, the A and B periods overlap on one calendar day (October 28, 2008). Thus, the proper PTA is 466 (A delay) + 581 (B delay) - 1 (overlap of A and B periods) - 19 (applicant delay) = 1027 days, not 475 days as calculated by the Patent Office.

The '074 patent is not subject to a terminal disclaimer.

Conclusion

For all the reasons stated above, the patentee respectfully submits that the proper PTA is 1027 days and requests appropriate correction.

Fee Authorization: The Commissioner is authorized to charge the cost of any fees that may be associated with the filing of this Petition to Deposit Account No. 13-2490.

If there are any questions or comments regarding this application, the Office is encouraged to contact the undersigned in order to expedite prosecution.

Respectfully submitted,

Date: August 21, 2009

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